

REMARKS

In the Office Action, the Examiner:

- 1 Rejected claims 1-9, 11-26, and 28-33 under 35 U.S.C. § 103(a) as being unpatentable over Picco (U.S. 6,029,045) in view of Lindstrom (U.S. 5,029,014) and in further view of Zigmund (U.S. 6,571,392); and
- 2 Rejected claims 10 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Picco (U.S. 6,029,045) in view of Lindstrom (U.S. 5,029,014) and in further view of Zigmund (U.S. 6,571,392).

1.131 Affidavit To Remove Zigmund Reference

As noted above, the Examiner rejected claims 1-9, 11-26, and 28-33 and claims 10 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Picco (U.S. 6,029,045) in view of Lindstrom (U.S. 5,029,014) and in further view of Zigmund (U.S. 6,571,392). The Applicants have submitted an affidavit under 37 CFR 1.131 herewith to overcome the Yen reference. The May 27, 2003 issue date of the Zigmund reference is not more than one year from the filing date of the above referenced patent.

Accordingly, it is respectfully submitted that the rejection of claims 1-9, 11-26, and 28-33 and claims 10 and 27 under 35 U.S.C. §103(a) should be withdrawn. No new matter has been added. It is respectfully requested that the rejections and/or objections stated in the Office Action be reconsidered and withdrawn, and that the claims be allowed. A favorable Action is requested.

Rejection under 35 U.S.C. §103(a) Picco, Lindstrom and Zigmund

Although the Applicants have removed the Zigmund reference, the Applicants further distinguish the Picco taken alone and/or in view of Lindstrom and/or in view of the

Zigmond reference. Specifically Picco, Lindstrom and/or in view of Zigmond are silent on:

wherein the play-list contains a multimedia segment availability time when the multimedia segment in the play-list is to be received prior to the time the multimedia segment is to be rendered; and

determining if all the multimedia segments required by the play-list have been received according to the multimedia segment availability time and in response to one or more multimedia segments not being so received, then requesting one or more missing multimedia segments from a secondary media source different than the primary media source from which the multimedia segments were previously requested but not received, wherein the secondary media source is selected from the group of secondary media sources consisting of a second broadcast channel, internet, and removable computer readable medium wherein the play-list contains a multimedia segment availability time when the multimedia segment in the play-list is to be received prior to the time is to be rendered;

This is important because as taught on page 14, lines 19-17 of the specification as originally filed reproduced with emphasis below for convenience:

The combined set-top box 43, may also be optionally required to check that materials represented on the play-list 300 are available at some customizable point before the time required by the play-list 300. That is, if material M, to be available locally from the combined set-top box 43, is scheduled on the play-list 300 for 2PM, the set-top box 43 may be required to verify at 1PM that the Material M has been received and is available. Failing such a check may require the set-top box 43 to alert another device or entity, or to take remedial action. These sources include broadcast television, the Internet, CDS, DVDs and any other telecommunications and cable distribution and computer readable

mediums.

The present invention ensures that enough time is available prior to rendering the message to have the message available locally. This is important because depending on the segment size and the bandwidth from which the segment is being requested, there must be enough time prior to rendering the multimedia segment to have the segment stored. Stated differently, receiving a thirty second commercial over a dial-up internet connection requires much more time than receiving the same segment over a broadcast channel.

The combination of Picco, Lindstrom, and Zigmond as suggested by the Examiner teaches away from this more sophisticated play-list because Zigmond expressly teaches retrieving the information resource over the Internet in FIG. 3 step 307 and FIG. 5, step 504 but there is no timing relationship of when the information must be available locally. Stated differently, Zigmond expressly teaches downloading information from an alternate channel and presenting the information as a web page along with the television video. See Zigmond, col. 3, lines 35-39. However, the system in Zigmond using a slow internet connection such as dial-up may not receive all the information over a slow internet connection in time for the "trigger" in col. 2, lines 35-40 to render the information as a webpage with the related television video to display as the page is received. Accordingly, Zigmond is inoperable in this regard to tracking when a "multimedia segment in the play-list is to be received prior to the time the multimedia segment is to be rendered." The Federal Circuit has consistently if references taken in combination would produce a "seemingly inoperative device," that such references teach away from the combination and thus cannot serve as predicates for a *prima facie* case of obviousness. See Michael L McGinley vs. Franklin Sports, Inc. (Fed Cir 2001) citing *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (references *teach away* from combination if combination produces seemingly inoperative device); see also *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification *teaches away*).

Continuing further, when there is no suggestion or teaching in the prior art for:

wherein the play-list contains a multimedia segment availability time when the multimedia segment in the play-list is to be received prior to the time the multimedia segment is to be rendered.

wherein the play-list contains a multimedia segment availability time when the multimedia segment in the play-list is to be received prior to the time the multimedia segment is to be rendered; and

determining if all the multimedia segments required by the play-list have been received according to the multimedia segment availability time and in response to one or more multimedia segments not being so received, then requesting one or more missing multimedia segments from a secondary media source different than the primary media source from which the multimedia segments were previously requested but not received, wherein the secondary media source is selected from the group of secondary media sources consisting of a second broadcast channel, internet, and removable computer readable medium wherein the play-list contains a multimedia segment availability time when the multimedia segment in the play-list is to be received prior to the time is to be rendered;

the suggestion can not come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The references of Picco, Lindstrom and/or in view of Zigmund do not even suggest, teach nor mention this type of multimedia availability segment time.

Accordingly, independent claims 1, 11, 18, and 28 distinguish over Picco, Lindstrom and/or in view of Zigmund for at least these reasons.

Independent claims 1, 11, 18, and 28 have been amended to distinguish over Picco, Lindstrom and/or in view of Zigmond. Claims 2-10, 12-17, 19-27, and 29-33 depend from claims 1, 11, 18, and 28 respectively. Since dependent claims contain all the limitations of the independent claims, claims 2-10, 12-17, 19-27, and 29-33 distinguish over Picco, Lindstrom and/or in view of Zigmond, as well.

CONCLUSION

The remaining cited references have been reviewed and are not believed to effect the patentability of the claims as previously amended.

In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to the disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §§ 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE, if for any reason the Examiner finds the application other than in condition for allowance, the Examiner is invited to call either of the undersigned attorneys at (561) 989-9811 should the Examiner believe a telephone interview would advance the prosecution of the application.

Respectfully submitted,

Date: May 3, 2004

By:


Jon A. Gibbons
Registration No. 37,333
Attorney for Applicants

FLEIT, KAIN, GIBBONS,
GUTMAN, BONGINI & BIANCO P.L.
One Boca Commerce Center, Suite 111
551 Northwest 77th Street
Boca Raton, FL 33487
Tel. (561) 989-9811
Fax (561) 989-9812

BC9-99-024

Page 15 of 15

09/412,969